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| 28249  | 7590        | 11/24/2004           | EXAMINER            |                  |
| DILWORTH & BARRESE, LLP<br>333 EARLE OVINGTON BLVD.<br>UNIONDALE, NY 11553 |             |                      | ZHOU, TING          |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2173                |                  |
| DATE MAILED: 11/24/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/038,312

Applicant(s)

HONG, JUN-IL

Examiner

Ting Zhou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The amendment filed on 24 September 2004 have been received and entered. Claims 1-5 are pending in the application.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Horwitz et al. U.S. Patent 5,774,866.

Referring to claim 1, Horwitz et al. teach a method comprising the steps of registering the related function for the state indicator when a state change to be reflected in the representation of the state indicator occurs (for example, when conflicting search results are found, an alarm status flashing icon is displayed; the flashing icon has the registered functionality that if the user selects the icon, a list of potential matters which produced the conflict can be displayed) (column 21, lines 1-15), altering the state representation of the state indicator (displaying an alarm status flashing icon when conflicting search results are found) (column 21, lines 8-11) and invoking the registered function upon receipt of a user input for designating the state indicator (if the user selects the alarm status flashing icon, selected information associated with the icon, such as the list of potential matters which produced the conflicts, are displayed for the evaluator) (column 21, lines 1-15 and 26-30).

Referring to claim 2, Horwitz et al. teach a method comprising the steps of registering the related function for the state indicator when a state change to be reflected in the representation of the state indicator occurs (for example, when conflicting search results are found, an alarm status flashing icon is displayed; the flashing icon has the registered functionality that if the user selects the icon, a list of potential matters which produced the conflict can be displayed) (column 21, lines 1-15), altering the state representation of the state indicator (displaying an alarm status flashing icon when conflicting search results are found) (column 21, lines 8-11), determining whether the coordinates of a screen input indicate the representation area of the state indicator upon receipt of the touch screen input (determining if the user has selected the icon through the input means, which includes a touch screen input) (column 9, lines 2-6 and column 21, lines 11-15), and invoking the registered function when the coordinates of the screen input indicate the representation area of the state indicator (if the user did select the alarm status flashing icon, selected information associated with the icon, such as a list of potential matters which produced the conflict, are displayed for the evaluator) (column 21, lines 1-15 and 26-30).

Referring to claim 3, Horwitz et al. teach a method comprising the steps of registering the related function for the state indicator when a state change to be reflected in the representation of the state indicator occurs (for example, when conflicting search results are found, an alarm status flashing icon is displayed; the flashing icon has the registered functionality that if the user selects the icon, a list of potential matters which produced the conflict can be displayed) (column 21, lines 1-15), altering the state representation of the state indicator (displaying an alarm status flashing icon when conflicting search results are found) (column 21, lines 8-11), determining whether a cursor or an input focus is positioned over a representation area of the state indicator

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upon receipt of a user button input (determining if the user has selected the icon through the input means) (column 9, lines 2-6 and column 21, lines 11-15), and invoking the registered function when the cursor or input focus is positioned over the representation area of the state indicator (if the user did select the alarm status flashing icon, selected information associated with the icon, such as a list of potential matters which produced the conflict, are displayed for the evaluator) (column 21, lines 1-15 and 26-30).

Referring to claim 5, Horwitz et al. teach a method comprising the steps of registering an alarm function for the state indicator when the alarm is set (for example, when the alarm status flashing icon is displayed on the screen, i.e. when the alarm is set, a function of displaying a list of potential matters which produced the alarm is associated with the alarm icon so that when the user selects the alarm icon, the list is displayed to the evaluator) (column 21, lines 1-15), displaying the state indicator (displaying an alarm status flashing icon when conflicting search results are found) (column 21, lines 8-11), determining whether coordinates of a touch screen input indicate a representation area of the state indicator upon receipt of the touch screen input (determining if the user has selected the icon through the input means, which includes a touch screen input) (column 9, lines 2-6 and column 21, lines 11-15), and invoking the alarm function when the coordinates of the touch screen input indicate the representation area of the state indicator (if the user did select the alarm status flashing icon, selected information associated with the icon, such as a list of potential matters which produced the conflict, are displayed for the evaluator) (column 21, lines 1-15 and 26-30).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oran et al. U.S. Patent 5,617,526 and Horwitz et al. U.S. Patent 5,774,866.

Referring to claim 4, Oran et al. teach a method comprising the steps of registering a message reading function for the state indicator when the message arrives (registering the function of reading a new email via an email application with an email icon; for example, when a new mail arrives, an email icon is displayed such that when the user selects the icon, he can look at the newly arrived mail) (Oran et al.: column 4, lines 20-30 and 42-50), displaying the state indicator (displaying the mail icon indicating the change in the email application, i.e., a new mail has arrived) (Oran et al.: column 5, lines 37-46), determining whether coordinates of a screen input indicate a representation area of the state indicator upon receipt of the screen input (determining if the user has positioned the mouse cursor on the icon and double clicked the icon) (Oran et al.: column 4, lines 20-24) and invoking the message reading function when the coordinates of the touch screen input indicate the representation area of the state indicator (if the user did position the mouse cursor over the icon and double clicked the icon, the function associated with the icon, such as opening the email application to read the newly arrived mail, is performed) (Oran et al.: column 4, lines 20-30 and 42-50). However, Oran et al. fail to teach the input being a touch screen input. Horwitz et al. teach a method for the display and selection of

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status indicators (such as the display and selection of the alarm status flashing icon when conflicting search results are found) (Horwitz et al.: column 21, lines 1-15) similar to that of Oran et al. In addition, Horwitz et al. further teach using a touch screen input to make onscreen selections (Horwitz et al.: column 9, lines 2-6). It would have been obvious to one of ordinary skill in the art, having the teachings of Oran et al. and Horwitz et al. before him at the time the invention was made, to modify the method for associating a function with an indicator of Oran et al. to include the use of touch screen inputs taught by Horwitz et al. One would have been motivated to make such a combination in order to avoid the inconvenience of attaching a mouse or keyboard to devices that are small in size, such as handheld devices like PDAs and cell phones.

#### ***Response to Arguments***

4. Applicant's arguments filed on 24 September 2004 have been fully considered but they are not persuasive.

5. Applicant asserts that Horwitz et al. do not teach the inventive method of the present application, specifically, it does not teach "registering the related function for the state indicator when a state change to be reflected in the representation of the state indicator occurs. The examiner respectfully disagrees. Horwitz et al. teach when a state change is reflected in the representation of the state indicator, i.e. when an alarm indicator such as a flashing icon is displayed on the terminal, and the user selects this flashing icon, a list of potential matters which produced the conflict are displayed, as recited in column 21, lines 1-30; in other words, when a

state change in the representation of a state indicator such as a flashing icon occurs, the related function of displaying selected information upon detecting selection of the icon is associated with the icon so that when the user selects the icon, a list of information is displayed.

6. In addition, applicant asserts that Oran et al. also fails to teach registering the related function for the state indicator when a state change to be reflected in the representation of the state indicator occurs, specifically that Oran et al. fail to teach “registering a message reading function for the state indicator when the message arrives”. The examiner respectfully disagrees. Oran et al. teach displaying an envelop icon when a new email arrives such that when the user selects the envelope icon, he can look at the new mail (column 4, lines 20-50 and column 5, lines 34-46); in other words, when a message arrives, such as arrival of a new email, indicated by the display of an envelope icon, a message reading function is registered with the envelope icon in order to allow users to look at the electronic message when the envelop icon is selected. As a further example, in the similar example of the printer icon associated with the printer application recited in column 4, lines 20-38, when the message indicator for the printer application arrives, i.e. upon the display of a printer icon on the taskbar notification area, a message reading function of opening the print manager is associated with the printer icon so that selection of the printer icon results in the opening of the print manager window. Therefore, it can be seen that both Horwitz et al. and Oran et al. anticipate the subject invention.

7. Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,



“the registering element claimed in the present application produces dynamic results”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-4058.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

16 November 2004



**RAYMOND J. BAYERL**  
**PRIMARY EXAMINER**  
**ART UNIT 2173**